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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/770,556	01/26/2001	Venkatesh Krishnan	10006129-1	6414

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HEWLETT-PACKARD COMPANY
Intellectual Property Administration
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Fort Collins, CO 80528-9599

EXAMINER

LEE, PHILIP C

ART UNIT	PAPER NUMBER
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2154

DATE MAILED: 05/06/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/770,556

Applicant(s)

KRISHNAN ET AL.

Examiner

Philip C Lee

Art Unit

2154

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 24 December 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-17 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-17 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 5.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

1. Claims 1-17 are presented for examination.
2. It is noted that although the present application does contain line numbers in the specification and claims, the line numbers in the claims do not correspond to the preferred format. The preferred format is to number each line of every claim, with each claim beginning with line 1. For ease of reference by both the Examiner and Applicant all future correspondence should include the recommended line numbering.

Claim Rejections – 35 USC 112

3. Claims 1-17 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.
 - a. The following terms lack proper antecedent basis:
 - i. the communication module – claim 9.
 - b. Claim language in the following claims is not clearly understood:

- i. As per claim 1, line 9, it is unclear what is a key chain tag-size [i.e. what is consider the dimension of a key chain tag?]; Line 7, it is not clearly understood what is meant by user control “commend”[i.e. command?].
- ii. As per claim 3, line 3, it is uncertain what is meant by “approximately”.
- iii. As per claim 8, line 7, it is not clearly understood what is meant by user control “commend”[i.e. command?].
- iv. As per claim 8, line 12 and claim 17, line 3, they contain the similar uncertainties as in claim 3, line 3.
- v. As per claim 15, line 7, it is not clearly understood what is meant by user control “commend”[i.e. command?]; Line 9, it contains the similar uncertainty as in claim 1, line 9.
- vi. As per claim 16, line 4, the claim is not complete.

Claim Rejections – 35 USC 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 1-5, 7-12 and 14-17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Weiser et al, U.S. Patent 5,982,520 (hereinafter Weiser) in view of Utsumi, U.S. Patent 6,243,741 (hereinafter Utsumi).

6. As per claims 1, 8-9 and 15, Weiser taught the invention substantially as claimed comprising:

a sender that electronically sends digital information to an external Internet appliance (col. 2, lines 24-28);

a receiver that electronically receives digital information from an external Internet address transmitter (col. 2, lines 24-28);

a storage that stores digital information (col. 2, lines 10-16, 24-28);

a user interface that receives a user control command as to send or receive a digital information, and displays the digital information sent or received (col. 3, lines 18-22, 52-53; col. 6, lines 27-30, 38-40, 59-62; col. 8, lines 25-27, 39-42), wherein the internet appliance remote operator is a key chain tag-sized device (col. 3, lines 3-4; col. 4, lines 22-24).

7. Weiser did not specifically detailing types of digital information. Utsumi taught transmitting a web address (URL) to an Internet television (col. 7, lines 22-42).

8. It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teachings of Weiser and Utsumi because Utsumi's teaching of

transmitting a web address would increase the user flexibility of Weiser's system by allowing remote transmission of web address (URL) to an Internet television for accessing the Internet (col. 7, lines 22-31).

9. As per claims 2 and 16, Weiser and Utsumi taught the invention substantially as claimed in claims 1 and 15 above. Weiser further taught comprising a processor coupled to the sender, the receiver, the storage, and the user interface to cause the sender or receiver to send or receive the web address in response to the user control command received from the user interface (fig. 2; col. 3, lines 3-10; col. 4, lines 54-67; col. 3, lines 18-22, 52-53; col. 6, lines 59-62).

10. As per claims 3 and 17, Weiser and Utsumi taught the invention substantially as claimed in claims 1 and 15 above. Weiser further taught wherein the sender, the receiver, and the storage all reside in an enclosure that is approximately of the size of a key chain tag (fig.2; col. 3, lines 3-10; col. 4, lines 54-col. 5, lines 4).

11. As per claims 4 and 10-11, Weiser and Utsumi taught the invention substantially as claimed in claims 1 and 9 above. Weiser further taught wherein the sender is a beacon sender that transmits wirelessly a beacon signal containing the web address, wherein the beacon sender has a predetermined transmission range (col. 3, lines 39-45; col. 4, lines 57-60; col. 5, lines 13-25).

12. As per claims 5 and 12, Weiser and Utsumi taught the invention as claimed in claims 3 and 9 above. Weiser further taught wherein the receiver is a beacon receiver that receives external electronic transmission containing a web address, and extracts the web address from the transmission (col. 4, lines 57-60; col. 7, lines 13-17; col. 8, lines 30-34).

13. As per claims 7 and 14, Weiser and Utsumi taught the invention as claimed in claims 1 and 8 above. Weiser further taught wherein the user interface allows the user to manually input a web address to the storage, wherein the user interface also includes a customized control function that allow the operator to send a user-specified web address (col. 7, lines 22-42).

14. Claims 6 and 13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Weiser and Utsumi in view of Wiener et al, U.S. Patent 6,701,317 (hereinafter Wiener).

15. As per claims 6 and 13, Weiser and Utsumi taught the invention substantially as claimed in claims 1 and 8 above. Weiser and Utsumi did not teach partitioning the storage area. Wiener taught wherein the storage is partitioned into a general storage area and a customized storage area that stores user-specified web addresses (col. 8, lines 47-col. 9, lines 5).

16. It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teachings of Weiser, Utsumi and Wiener because Wiener's method of partitioning the storage area would increase the user flexibility of Weiser's and Utsumi's systems

by allowing the user to store important web addresses (URLs) in different partitioned storage (col.8, lines 47-53).

CONCLUSION

17. A shortened statutory period for reply to this Office action is set to expire **THREE MONTHS** from the mailing date of this action.

18. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Philip C Lee whose telephone number is (703)305-7721. The examiner can normally be reached on 8 AM TO 5:30 PM Monday to Thursday and every other Friday.

19. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Follansbee can be reached on (703)305-8498. The fax phone number for the organization where this application or proceeding is assigned is (703)872-9306.

20. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703)350-6121.



**JOHN FOLLANSBEE
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